



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

5

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☒ This application has been examined ☒ Responsive to communication filed on 3/31/94 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire three month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|-----------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------------|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 19-39 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-18 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 19-39 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

INFORMALITIES

1. The information disclosure statement filed 3/31/94 fails to comply with 37 CFR § 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered as to the merits.

2. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the title of the invention, each of the lettered items should be preceded by the headings indicated below.

- (a) Title of the Invention.
- (b) Cross-References to Related Applications (if any).
- (c) Statement as to rights to inventions made under Federally-sponsored research and development (if any).
- (d) Background of the invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 C.F.R. §§ 1.97-1.99.
- (e) Summary of the Invention.
- (f) Brief Description of the Drawing.
- (g) Description of the Preferred Embodiment(s).
- (h) Claim(s).
- (i) Abstract of the Disclosure.

Specifically, the application does not contain a "Summary of the Invention."

CLAIMS

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

5 The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10 The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification as originally filed does not provide support for the invention as now claimed.

15 Specifically, the specification is silent of a third alert generator, is silent of a periodic visual alert, and is silent of a third generator operating totally inclusive of the first generator (at the same time). Furthermore, having a keypad used to generate a second call is not supported by the original specification.

4. Claims 25-32,39 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

20 5. Claims 21,22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 21 and 22, the term "the RF call signals is unclear, especially claim 22, wherein the speaker is coupled to the receiver. Is is the first RF call signal, the second RF call signal or both the first and

second RF call signals.

ART REJECTION

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7. Claims 19-24,26-31,33-38 are rejected under 35 U.S.C. § 103 as being unpatentable over Breeden and Yamasaki. Yamasaki shows a radio including a receiver 2 which receives an information signal. The radio also includes a silent alert means 10 and an audible alert means 12. The radio also including a processing means 3,5,6,8. The processing means activates the silent alert for a first time t1, then activates the audible alert for a second time (t1-t2) wherein t1 is exclusive of t2, and the second time follows the first time, ie only one alert at a time (see figure 2). Audible and vibrating alerts are periodic and since there is a limited time for their activity, the times of activation would inherently equal a specific number of cycles.

Yamasaki teaches the silent alert first and alternatively the audible alert first, see col. 5 lines 40-44. Yamasaki accomplishes efficiency in power utilization in the above scheme. In an analogous art, Breeden shows a radio RF receiver which includes a processor 454 and a transmitter and receiver. Breeden teaches the radio receiver can
5 also function as a transmitter to transmit a second RF signal. This signal is created by an audio transducer (microphone) 458 or a keypad 466. The second signal is transmitted via an antenna. Breeden uses a display 464 to display RF call signals, a speaker to emit RF call signals 458. Breeden suggests the utilization of common audible, visual and tactile alerts, leaving the details to the routineer. Therefore, it
10 would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the alerting function of Yamasaki in a bidirectional voice pager of Breeden to efficiently save battery power. The examiner takes official notice that pagers commonly (necessarily) include a battery for power. The examiner also takes notice that it is common to utilize the same antenna for transmission and reception
15 (this is suggested by Breeden 452).

8. Claims 25,32,39 are rejected under 35 U.S.C. § 103 as being unpatentable over Breeden and Yamasaki as applied to claims 19,24,26,31,33,38 above, and further in view of Ohyanagi. Breeden suggests the use of a visual indicator. In an
20 analogous art, Ohyanagi uses a flashing (periodic) light in combination with another alert mode. See col. 3 lines 1-12. This helps alert the user that a call has been

received. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the visual alert in combination with another alert as taught by Ohyanagi in the above modified device, to help alert the user that a call has been received.

5

DOUBLE PATENTING

9. Claims 19,26,33 are provisionally rejected under the judicially created doctrine of non-obviousness-type double patenting as being unpatentable over claims 1,18,19,20 of U.S. application No. 220949 and claims 19,24,29,34 of U.S. application
10 No. 220856.

The non-obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Schneller*, 397 f.2d 350,158 USPQ 210(CCPA 1968). A
15 timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

A two part test is applied to the claims. 1) is the subject matter recited in the
20 claims of the application fully disclosed in the patent and covered by a claim in the patent. If yes, the second test is 2) is there any reason why applicant was prevented

from presenting the same claims for examination in the issued patent (application) if the answer is no a double patenting rejection is appropriate.

Here, the subject matter recited in the pending claim is fully disclosed in the applications referred above and covers the same subject matter covered by claims 1,18,19,20 of U.S. application No. 220949 and claims 19,24,29,34 of U.S. application No. 220856. Further, there was no reason why applicant was prevented from presenting the same claim for examination in the other application. The applicant has not maintained a clear line of demarkation between the above applications.

Furthermore, the applicant appears to intend the above applications referring to the same subject matter since all have the same title.

10. Claims 21-25,28-32,35-39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,18,19,20 of U.S. application No. 220949 and claims 19,24,29,34 of application No. 220856 in view of Breeden and Ohyanagi as discussed above.

11. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Zimmerman whose telephone number is (703) 305-4796.

- 5 Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4900.

10 Brian Zimmerman
Patent Examiner
Art Unit 2604

baz
703-305-4796
15 December 28, 1994

A handwritten signature in cursive script, appearing to read "Brian Zimmerman", is written over the printed name and title.